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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,637	08/07/2001	Larry Bowen	00417.00003	9687

22907 7590 06/19/2002

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EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 06/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

53

Office Action Summary	Application No.	Applicant(s)	
	09/922,637	BOWEN ET AL.	
	Examiner	Art Unit	
	Dionne A. Walls	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-130 is/are pending in the application.
- 4a) Of the above claim(s) 69-109 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 110-113, 116-118, 120, 121 and 123-130 is/are rejected.
- 7) ☒ Claim(s) 114, 115, 119 and 122 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8-7-2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 103-123 have been renumbered 110-130.

2. Claim 111 is objected to because of the following informalities: In line 1 of this claim, "mater" should be changed to --material--.

Appropriate correction is requested.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims ⁶³~~69~~-109, drawn to sheet material for application to a cigarette, classified in class 131, subclass 365.
- II. Claims 110-130, drawn to a dry precursor cigarette sheet material/method of treating sidestream smoke, classified in class 131, subclass 365.

The inventions are distinct, each from the other because of the following reasons:

4. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

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shown to be separately usable. In the instant case, invention I has separate utility such as a sheet material for wrapping a cigarette wherein said wrapper has a porosity of about 200 Coresta, a pore size of about 50 angstroms to 2 microns; a BET surface area greater than 20 meter squared/gram; and density of about .3 - .8 grams/cubic centimeter; and a sheet thickness of about .04 mm to about 1 mm. See MPEP § 806.05(d).

5. During a telephone conversation with Mr. Brian Hanlon on May 31st, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 110-130. Affirmation of this election must be made by applicant in replying to this Office action. Claims 69-109 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 110-113, 116-118, 120-121, and 123-130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (US. Pat. No. 4,915,117).

Ito discloses a sheet for holding tobacco, said sheet formed of ceramic fibers which may include zirconia, alumina or titanium oxide (corresponding to the claimed "non-combustible material/oxygen storage component/group IVB metal oxide/catalyst"); glass fiber (corresponding to the claimed "sheet reinforcement"), singly or in combination with aluminoborosilicate (corresponding to the claimed "oxygen storage component/catalyst/aluminum silicates"); a binder, which can be either organic or inorganic and can consist of starch, silica gel, rubber-type adhesives or natural resins (which also corresponds to the claimed "sorber/porous metal oxide/plastic/cellulose materials"); and cellulose pulp fiber (corresponding to the claimed "organics"). The sheet comprised of such fibers/additives such that upon smoking of the cigarette having the sheet as a wrapper, no harmful organic substances are produced (corresponding to the claimed "activating said sheet material...at a high temperature cigarette burn zone of the cigarette") (see entire patent). While there may be no explicit statement that the cellulosic pulp fiber or organic binder is combustible at the high-temperature burning zone of the cigarette, it would follow that since the cellulosic pulp/organic binder is derived from a cellulose/wood source (which are themselves combustible materials) said materials would also burn or combust when subjected to high-temperatures. While Ito may state a preferred amount of ceramic fiber/oxygen storage component/catalyst that is outside of the claimed range, it also states that the mixture may be selected taking into consideration ignitionability, adhesion to tobacco and combustion. (col. 6,

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lines 24-26). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to arrive at the claimed amounts based on the desired combustibility, and /or ignitability of the smoking product in order to achieve an optimal blend of ceramic fibers along with the other additives for the enjoyment of the intended smoker.

Allowable Subject Matter

9. Claims 114-115, 119, and 122 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

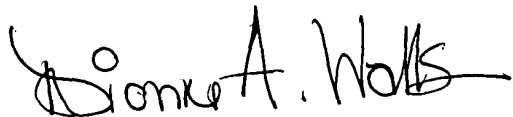
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Dionne A. Walls
June 17, 2002